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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/080,309 | 02/22/2002 | Sung Woo Yang | 742-01110503 | 8183 |

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CHARLES C.H. WU
98 DISCOVERY
IRVINE, CA 92618-3105

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| EXAMINER |
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ZURITA, JAMES H

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| ART UNIT | PAPER NUMBER |
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3625

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/080,309 | Applicant(s) YANG, SUNG WOO | |
| | Examiner James H Zurita | Art Unit 3625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant amendment of 24 November 2004 included amendment of claims 1 and 6.

Claims 1-7 are pending and will be examined.

Response to Arguments

Applicant's arguments filed 24 November 2004 have been fully considered.

Drawing objections remain. Applicant submitted a drawing for Fig. 5, but failed to include amended Fig. 3 and 4 as stated. Please refer to previous office action.

Double patenting rejection will be withdrawn on receipt of terminal disclaimer.

Rejection of claim 1 as indefinite is withdrawn based on applicant's explanation that his invention is limited to "...displaying input means...", that is, displaying an input means, such as a display on a screen that must also be able to serve to accept input.

In claim 6, applicant's change of "...simultaneously..." to "...in parallel..." does not overcome rejection under 35 USC 112 for reasons stated in prior office action and expanded upon below. The term "parallel" does not appear in the disclosures. The term "parallel" refers to processes that occur simultaneously.¹ Please refer to previous office action for rejection.

Claim 7 rejection stands, as claim 7 retains the term "...simultaneously..." See prior office action for explanation.

¹ Definition of parallel, RANDOM HOUSE Computer and Internet Dictionary.

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Applicant's arguments concerning rejection under 35 USC 103 are not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 uses the term "means for." This appears to be an attempt to invoke 35 U.S.C. 112, sixth paragraph, to recite claim element as a means for performing a specified function. See rejection in prior office action.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamonoue (US 6,745,180) in view of Garrett (US 6,473,738).

As per claim 1, Yamanoue discloses methods for searching and ordering books via the Internet, including the steps of:

(a) at a server, storing book identifying information for every book carried by the vendor in a main database; see, for example, at least Figs. 1 and 13, items 21, 39 and related text.

(b) at a server, storing book identifying information for every book previously ordered by a customer in a customer database; see, for example, at least references to user databases, Fig. 1, 13, item 32 and related text.

(c) at a client, displaying a screen to assist in entering book identifying information,. See, for example, at least Fig. 16 and related text.

(d) at a server, accessing the main database to match the book identifying information entered by the customer with the book identifying information stored in the main database and generating a search result comprising the matching book identifying information. See, for example, Col. 8, lines 35-48.

(e) at a client, displaying the search result. See, for example, at least Fig. 16 and related text.

(f) at a server, in response to book identifying information entered by the customer in the input means, accessing the customer database to match the book identifying information entered by the customer with the book identifying information stored in the customer database and generating a previous orders result comprising the matching book identifying information. See, for example, at least Fig. 16 and related text, showing books already ordered by a customer.

(g) at a client, displaying the previous orders result; see, for example, at least Fig. 16 and related text.

Yamanoue **does not** provide specific details concerning (h) entering orders for books and (i) generating book orders. Garrett discloses order fulfillment. In Garrett, see, for example, at least Figs. 18-22 and checkout process.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yamanoue and Garrett to disclose (h) entering orders for books and (i) generating book orders.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Yamanoue and Garrett to disclose (h) entering orders for books and (i) generating book orders for the obvious reason that one may wish to manage a multiple-person shopping experience by being able to compare and keep separate selections for different parties.

As per claim 2, Yamanoue **does not** use the terms ISBN and international standard book number. Garrett discloses that book identifying information may comprise an international standard book number. See, for example, at least Fig. 3 and related text, Col. 9, lines 4-17. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yamanoue and Garrett to disclose the use of ISBN. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Yamanoue and Garrett to disclose the use of ISBN for the obvious reason that ISBN's provide a quick, efficient way of entering and obtaining information concerning a book, thereby decreasing search time and making a shopping experience quicker.

As per claim 3, Yamanoue discloses that book identifying information may comprise a title. See, for example, at least Col. 1, lines 1-33.

As per claim 4, Yamanoue discloses that book identifying information may comprise an author. See, for example, at least Col. 1, lines 1-33.

As per claim 5, Yamanoue discloses that book identifying information may comprise a subject. See, for example, at least references to keyword searches, Fig. 3 and related text.

As per claim 6 Yamanoue discloses simultaneously displaying several types of information, as in Fig. 16 and related text. See also claim 1, above:

(a) at a server, storing book identifying information for every book carried by the vendor in a main database; see, for example, at least Figs. 1 and 13, items 21, 39 and related text.

(b) at a server, storing book identifying information for every book previously ordered by a customer in a customer database; see, for example, at least references to user databases, Fig. 1, 13, item 32 and related text.

(c) at a client, displaying a screen to assist in entering book identifying information,. See, for example, at least Fig. 16 and related text.

(d) at a server, accessing the main database to match the book identifying information entered by the customer with the book identifying information stored in the main database and generating a search result comprising the matching book identifying information. See, for example, Col. 8, lines 35-48.

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(e) at a client, displaying the search result. See, for example, at least Fig. 16 and related text.

(f) at a server, in response to book identifying information entered by the customer in the input means, accessing the customer database to match the book identifying information entered by the customer with the book identifying information stored in the customer database and generating a previous orders result comprising the matching book identifying information. See, for example, at least Fig. 16 and related text, showing books already ordered by a customer.

(g) at a client, displaying the previous orders result; see, for example, at least Fig. 16 and related text.

As per claim 7, Yamanoue discloses simultaneous display of search result(s) and previous orders result(s). See, for example, at least Fig. 16 and related text.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 **James Zurita**
Patent Examiner
Art Unit 3625
04 March 2005


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600